

ESTTA Tracking number: **ESTTA544045**

Filing date: **06/19/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91205483
Party	Defendant Baba Slings Limited
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Date	06/19/2013
Attachments	Babasling - Motion to Compel - Reply.pdf(295328 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

BABA SLINGS PTY LTD.,

Opposer,

v.

BABASLINGS LIMITED,

Applicant.

Opp. No. 91-205,483
Serial No. 79/103,197

**APPLICANT’S REPLY IN SUPPORT OF
MOTION TO COMPEL DISCOVERY DEPOSITIONS**

Applicant Babaslings Limited (“Applicant”) hereby replies to the Response filed by Opposer Baba Slings Pty. Ltd. (“Opposer”) to Applicant’s motion to compel the discovery deposition of Opposer and/or its principal, Shanti McIvor.

I. Introduction

In its Response, Opposer does not dispute the core of this motion: namely, that Applicant properly noticed the deposition in the United States of Opposer (and its principal), a foreign entity, when Opposer was to be present here, per 37 CFR § 2.120(c)(2); Opposer did not object; Applicant agreed, at Opposer’s request, to reschedule that deposition; and six months later, after numerous emails regarding the rescheduling of that deposition, and with the discovery period nearing a close, Opposer suddenly reneged and refused to appear as agreed. Opposer instead now minimizes its agreement to reschedule the depositions, and contends, stunningly, that Applicant has no remedy since it never re-noticed the very depositions for which Opposer agreed (but now suddenly refuses) to provided available dates. Opposer, having sought and accepted the rescheduling of its U.S. deposition, should be compelled to abide by that agreement.

II. Argument

Opposer posits three arguments in its Response: (1) that Opposer “is an Australian company” whose principal “lives and works full time in Australia;” (2) Applicant “vacated” the original deposition notices and “never reset them” such that there is “nothing . . . to compel; and (3) Opposer “was not going to be in the United States” during the balance of the discovery period, and Applicant’s request was “with less than three weeks left in the discovery period.” Response at 1. All arguments are completely without merit.

1. Opposer’s Status an Australian Company is Immaterial.

The fact that Opposer is an Australian entity is immaterial because the deposition notice was served pursuant to the very rule that is designed to permit the discovery deposition of a foreign entity present in the United States: Trademark Rule 2.120(c)(2). *See* T.B.M.P. 404.03(d).

Opposer claims that Applicant “improperly” noticed these depositions, see Response at 2, but offers no analysis as to why Applicant’s original deposition notice was in any way defective. Opposer does not contend that it served any objections to these deposition notices, and does not contend that any objection was articulated formally or informally to Applicant or its counsel.

Indeed, if anything, Opposer argument on this point suggests, rather alarmingly, a belief on Opposer’s part that so long as it requested and received Applicant’s agreement to reschedule that deposition to another date, it could escape its obligation entirely. This most certainly is not the law and is grossly inconsistent with Board practices. *See* T.B.M.P. § 408.01.

2. Applicant Did Not “Vacate” the Depositions – They Were Rescheduled.

Opposer next contends that Applicant “vacated” the depositions and never renoticed them, such that Trademark Rule 2.120(e) does not permit a motion to compel. This argument wholly lacks factual or legal basis.

As the email chain in the supporting declaration indicates, the deposition notices were not “vacated” – rather, Applicant assented to Opposer’s request to reschedule, and released Opposer from its obligation to appear on that date. It was perfectly clear based on the email exchanges that Applicant agreed to reschedule only on the basis that Opposer agree to reappear in the United States for deposition at a later date.

The depositions were not re-noticed for the obvious reason that a deposition notice, per Fed. R. Civ. P. 30(b)(1), must state the date, time and location, and Applicant was awaiting receipt of convenient dates from Opposer so that the deposition notice could be written and served. Opposer remained obliged to honor its agreement.

Opposer cites no case for the proposition that a party forfeits its right to move to compel when a party agrees to reappear for deposition, but then expressly refuses to honor that commitment, unless some sort of perfunctory notice of deposition is served. This does not reflect the practical reality that there is no deposition notice to serve under Trademark Rule 2.120(c)(2) absent dates in which the party is known to be present in the United States, which Opposer agreed to provide. The Board has repeatedly recognized that deposition scheduling is a matter of cooperation among counsel, and has not hesitated to compel a deposition absent such cooperation. *See, e.g., HighBeam Mktg., LLC v. Highbeam Research, LLC*, 85 U.S.P.Q.2d 1902 (TTAB 2008) (“despite extensive efforts by applicant to schedule the depositions at issue, opposer has failed to cooperate in the scheduling and taking of the discovery depositions at issue. In view thereof, the motion to compel is granted.”).

There can be no contesting that this dispute is substantively ripe for adjudication, and is properly before the Board. There is no merit to Opposer’s suggestion that this Board somehow lacks the ability to enforce the discovery commitments voluntarily undertaken by parties and

their counsel. To hold otherwise would risk rendering this Board's admonition and expectation that parties cooperate in discovery matters purely voluntary.

3. Opposer's Schedule During the Balance of the Discovery Period Does Not Entitle Opposer to Renege on its Agreement.

Opposer's final argument, that it was not present during the balance of the discovery period, is entirely beside the point. Applicant never insisted that the deposition take place during that three week window – rather, as shown in the email correspondence, Applicant expressly offered to extend the deadlines to accommodate Opposer's schedule. It is Opposer that refused.

More to the point, since it was Opposer that requested the deposition be rescheduled, Opposer was required to honor its agreement. *See, e.g., The Sunrider Corporation v. Johannes W. Raats*, 83 U.S.P.Q.2d 1649 (TTAB 1997) (“Normally, the party asserting itself to be in a difficult position [in respect of deposition scheduling], here the applicant, should take the lead and suggest practical alternatives”). Common sense dictates that it be required to appear for deposition in the manner in which it was originally required – but here, this point was made express, as Applicant expressly condition its agreement to release Opposer from deposition upon it being rescheduled in the United States. Opposer accepted these terms without disagreement, and continued for months to state that new deposition dates would be supplied, until just days were left in the discovery period when Opposer reneged.¹

¹ Opposer parses this point, explaining that its email to “withdraw” from its agreement pertained to a telephonic deposition, and that there was no other agreement from which to withdraw. But as explained previously, Opposer's refusal to acknowledge its agreement to reappear for deposition in the United States is belied by the record, which plainly reflects that these were the terms on which Opposer was released from its required appearance – and that Opposer was fully aware of these terms and said nothing until months later, after stringing Applicant along, when it opportunistically saw an opportunity to deprive Applicant of *any* deposition. Whether or not Opposer acknowledges that it is withdrawing from its agreement, that is precisely what it did.

Relatedly, the suggestion that Applicant somehow delayed in requesting the deposition is frivolous. The email correspondence reflected in the supporting declaration shows that the parties remained in discussion about rescheduling the deposition, and Applicant contacted Opposer even before the suspension expired to reschedule the deposition, since post-suspension schedule allowed only a few weeks of discovery. Moreover, the record reflects that Applicant repeatedly asked Opposer to supply the alternate dates that it committed to provide, but Opposer never did so. Opposer's suggestion that Applicant is somehow responsible for Opposer's own delay and ultimate deception is patently ridiculous.

III. Conclusion

For the foregoing reasons, and those set forth in the previously, Applicant respectfully requests that its Motion to Compel be granted, and that relief be granted in the manner set forth at the conclusion of Applicant's Motion to Compel.

Respectfully submitted,



Dated: June 19, 2013

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CERTIFICATE OF SERVICE.

I hereby certify that on this date, a copy of the foregoing Motion to Compel Discovery Deposition was served on Opposer's counsel of record, by First Class Mail:

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Dated: June 19, 2013


